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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/716,918

11/20/2000

Jay S. Walker

98-010X

9324

7590

07/20/2005

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/716,918	WALKER ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION



This action is non-final.

Claims 55-70 are pending.



Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **50-77** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-49** of U.S. Patent No. 6,203,430. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The limitations of the instant claims including a method and a gaming device with a processor that tracks and counts the occurrence of a tracked symbol, increments or

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decrements the count value associated with the occurrence of the tracked symbol and associates an expiration condition and bonus payout based on the occurrence of the tracked symbol are taught by the claims of US 6,203,430.

Claims **50-77** provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-20** of copending Application No. 10/778,576.

This is a provisional obviousness-type double patenting rejection.

The limitations of the instant claims including a method and a gaming device with a processor that tracks and counts the occurrence of a tracked symbol, increments or decrements the count value associated with the occurrence of the tracked symbol and associates an expiration condition and bonus payout based on the occurrence of the tracked symbol are taught by the claims of Application No. 09/716918.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **50-54, 56-58, 60-62 64-69**, and **71-77** are rejected under 35 U.S.C. 102(e) as being anticipated by Barrie (US 5,833,537)

Regarding claims **50-53, 65-68, 71-73**, and **75-77** Barrie teaches generating at least one outcome wherein each outcome includes a plurality of instances selected from a plurality of machine symbols appearing on a plurality of pay-lines (Figure 1 & Abstract). The set of machine symbols including a plurality of persistent (tracked) slot machine symbols (124a, 124b, 124c) wherein on the occurrence of a persistent symbol a running count is adjusted in a respective counting grid (142, 144, Figure 7) respectively. The symbols of Barrie further independently expire due to the passage of time and/or the playing a predetermined number of subsequent rounds (Abstract). Barrie additional teaches the awarding of a bonus payout as determined by the count present in the counting grid (Figure 5).

Regarding claim **54**, Barrie teaches counting of tracked symbols for any payout amount (Figure 3). As so claimed the tracking of predetermined symbols occurs for any payout amount less then the predetermined amount above the maximum payout amount. In this light the applicant's "less than a predefined amount" is equated to any amount predefined above the maximum payout amount .

Regarding claim **56**, Barrie teaches remote game administration (Col 4:42-4:60) including a server system (central computer) for game state operation and tracking.

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Barrie utilizes remote hardware game management including all related processing functionality this is understood to encompass the storage and execution of software as well as performing as a server of the game to the remotely located player.

Regarding claims **57** and **58**, the claimed determination of a bonus payout based on the number of plays and/or the a duration of time is considered taught above by Barrie through the requirement of completing a grid prior to the expiration of at least one symbol presently held in the grid.

Regarding claim **60**, Barrie teaches awarding payouts (Figure 3 & Element 326) in response to the count and a placed wager(312), where the count excludes expired symbols (322).

Regarding claim **61**, Barrie teaches the use of offsetting symbols (black ball) for decrementing the count value with each occurrence of the black ball on a persistent symbol location (Col 4:8-22).

Regarding claim **62**, Barrie teaches the use of multiplier symbols wherein the bonus payout includes the determination of a multiplier to be applied to the payout (Figure 4).

Regarding claim **64**, Barrie teaches associating a zero payout for those symbols which have expired (Col 8:1-10 & Abstract) and as such encompasses the claimed "determining a payout for expired occurrences of the at least one tracked symbol".

Regarding claim **69**, Barrie teaches the use of a video poker embodiment including the use of playing cards (Col 3:2-5).

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Regarding claim **74**, Barrie teaches the incorporation of CPU (214) for the execution of game device taught above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **55**, **59**, and **63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5833,537) in view of Weiss (US 6,165,071)

Barrie teaches the inclusion of a "player card" however is silent regarding the memory, tracking, and player compensation abilities capabilities of said player card (Col 5:47-49). In a related application however Weiss teaches the use of a player card system (Weiss Col 2:24-27) for allowing a player to complete a game a in a series of

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gaming sessions including the storage of the player's current game state (*Weiss* Col 3:11-22), player tracking functions (*Weiss* Col 1:39-67), and the determination of player rewards for continued play (*Weiss* Col 1:39-56). It would have been obvious to one of ordinary skill in the art at the time of invention to have to have incorporated the continued play incentive program including the portions described above into the system/method of *Barrie* in order to encourage continued game play among player's.

Claim **70** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Barrie* (US 5833,537).

Barrie teaches providing a payout based on the results of a first game, the counting of predetermined symbols, and embodiments which further include the use of card games (Col 3:2-5) as taught above however *Barrie* is silent regarding the use of face value cards for the purpose tracked symbols. As no stated problem is solved or unexpected result obtained in the utilization of card face values in the place of the symbols of *Barrie* this feature is deemed to be a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time of invention to utilization of card face values in the place of the symbols of *Barrie* in order to allow the persistent symbol feature depiction in order to correspond the persistent symbols to a desired game theme.

Response to Arguments

Applicant's arguments with respect to claims **50-77** have been considered but are moot in view of the new ground(s) of rejection.

Applicant's remarks addressing the non-acceptance of terminal disclaimer filed June 28th 2004 have over looked a few points. The only parties who may file a terminal disclaimer are either an inventor or the attorney of agent of record. Magdalena M. Fincham is only attached to this particular application through the assignee and as such has the equivalent of an associate power of attorney (thereby allowing for this correspondence). The associate power of attorney however does not allow for the proper submission of terminal disclaimer. In the event that Magdalena M. Fincham's name or customer number was associated with the power of attorney attached to this case then a terminal disclaimer related to this application could properly be submitted.

The art of record has been changed to Barrie for consistency with related applications.

Applicant's challenge of the previous USC 103 rejections of claims **55, 56, 59,** and **62-64** have been rendered moot through the introduction of Barrie. Further Claims **55, 59,** and **63** which as present remain rejected under USC 103 have been further address with the introduction of Weiss in order to further clarify rejection.

Applicant's remarks addressing claim **64**, and in particular the claim language of "determining a payout" are non-persuasive. In particular the applicant appears to be associating functionally with the above phrase of a much narrower scope than that which, the language encompasses. This is most evident in the use of "determining" and "payout" which both allow for various interpretations including --not selecting a non-zero payout--, --selecting a zero payout--, --not selecting a zero payout--, ect. Further the prior art of Barrie teaches the determination of when and how much of payout to award

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Following such, Barrie must inherently determine when and how much not payout least Barrie would be incapable of determining when and how much to payout. As this relationship is defined inversely it would be nothing less then impossiable to have the exsistance of one aspect without the other and as such the "determining a payout for expired occurrences of symbols" is in point of fact present in any system that would determine a payout based on the exsistence of symbols such as set forth above in the rejection of claim **64**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JESSICA HARRISON
PRIMARY EXAMINER